



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,312	11/06/2003	Yoshinori Sekine	F-8028	8003
28107	7590	12/14/2006	EXAMINER	
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			DICUS, TAMRA	
		ART UNIT	PAPER NUMBER	
			1774	

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/702,312	SEKINE, YOSHINORI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tamra L. Dicus	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09-28-06 (Terminal Disclaimer).
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date. _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

The Examiner acknowledges the submitted Terminal Disclaimer and therefore withdraws the ODP rejection.

The claim objections are withdrawn because the claims have been amended.

The amendments to claims 3 and 4 are noted for the purpose of improving the form of the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,933,044 to Ishikawa.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Ishikawa teaches an insert-molded article comprising a film having transparency (2, FIGS. 3 and 4 and associated text), thermosoftening decorative print layer printed by use of a

Art Unit: 1774

crosslinking printing ink (7, FIGS. 3 and 4 and associated text) and a binder layer printed with use of a low crosslinking printing or non-crosslinking printing ink (8, FIGS. 3 and 4 and associated text), injected molded resin (4, FIGS. 3 and 4 and associated text). See also 5:1-25 and 6:5-50. The resins used in the layers are of polyester and the binder layer is partially crosslinked (equivalent to low-crosslinking effect of instant claims 3-4). The ink is also of crosslinked polyester (5:25-30). Claims 1-12 are met.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,682,679 to Marentic et al.

Marentic teaches an insert-molded article comprising a film having transparency (3:50-55, e.g. "clear" such that an image covered by the clear coat is substantially visible through the clear coat), thermosoftening decorative print layer printed by use of a crosslinking printing ink and a binder layer printed with use of a low crosslinking printing or non-crosslinking printing ink (3:5-20, 3:40-45, e.g. one or more intermediate crosslinkable polymer (binder) ink film having a desired image placed one on top of the other and the intermediate layers need not include a catalyst for crosslinking but can during the molding process), and a resin molded (4:30-55, 26, FIG. 7 and associated text, 15:35-16:20). See also 2, lines 15-68 and FIGS. 5-8 and associated text.

That the resin is molded by injection is a product by process limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process

invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Claims 1, and 7-12 are met.

Marentic teaches a crosslinked polyester resin and methacrylic resins (6:40-7:30) per instant claims 2 and 5-6.

Marentic also explains that in addition to just using one polyester ink base, a secondary saturated acid added in the crosslinked polyester resin ink effectively reduces the crosslinking and rigidity (7:1-5), thus this explanation is equivalent to a low-crosslinking ink degree that is lower than the other in the print layer as recited in claims 3-4.

#### *Response to Arguments*

Applicant's arguments filed 09-21-06 have been fully considered but they are not persuasive.

Applicant argues that crosslinking printing ink of Ishikawa is only in 6 and 7, stating 3 in FIGS. 3 and 4 noted in the prior Office Action is incorrect. However, Applicant noted FIG. 4, and the Examiner also referenced FIG. 4 and associated text, which clearly shows 7 and 8 having crosslinking ink and where 8 may contain a small amount or may not contain crosslinking agents which is equivalent to the instant binder layer printed with low or non-crosslinking printing ink. Thus because there is no new art that has been presented, and the basic thrust of the rejection remains the same, it is therefore not considered a new ground of rejection. See MPEP 1207.03: There is no new ground of rejection when the basic thrust of the rejection remains the same such

that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. Id. At 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

Applicant argues Marentic in that there is no disclosure of a single embodiment which can be identified as including all the elements of the present claimed invention. Applicant has not made a persuasive argument because Marentic clearly teaches all the elements where noted above and at col. 2, lines 15-30, col. 3, lines 5-45, teaching the backing has one or more intermediate layers over it and a molded resin outer layer. One or more, means it can contain 2, 3, and up to infinity and therefore need not show an embodiment for every single option, as the teaching is present. See MPEP 2123: Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Furthermore, “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

The rejections are sustained for reasons of record.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1774

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tamra L. Dicus  
Examiner  
Art Unit 1774

December 2, 2006



RENA DYE  
SUPERVISORY PATENT EXAMINER